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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,836	07/10/2001	Domenico Valerio	3837.1US	8961
24247	7590	06/03/2004	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			FALK, ANNE MARIE	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,836

Applicant(s)

VALERIO ET AL.

Examiner

Anne-Marie Falk, Ph.D.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1632

DETAILED ACTION

The amendment filed March 25, 2004 (hereinafter referred to as "the response") has been entered.

Claims 1, 2, 8, 10, and 14 have been amended. Claims 21-24 have been newly added.

Accordingly, Claims 1-15 and 21-24 are pending in the instant application.

The rejection of Claims 1-7 under 35 U.S.C. 112, first paragraph, for failure to provide an enabling disclosure for the full scope of the claims, is withdrawn in view of the amendment to the claim, which now recites an "*in vitro*" limitation.

The rejections of Claims 1-15 under 35 U.S.C. 102(b) are withdrawn in view of the amendments to the claims. However, the amended claims include new matter as set forth below.

The rejections of Claims 16-20 are withdrawn in view of the cancellation of these claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

New Matter

Claims 1-15 and 21-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 1632

The Examiner has reviewed the various sections of the specification to which Applicants refer at page 9 of the response of March 25, 2004. However, the Examiner does not find specific support for the new limitations recited in the claims. Claims 1 and 8 now recite “said first member of the specific binding pair not being a viral antigen naturally expressed on said delivery vehicle.” Claim 14 now recites that the “virus is derived from a virus ... by altering the capsid or envelope of said virus.” Applicants have not pointed to any support in the specification as-filed for this new limitation. At page 9, paragraph 3 of the response, as support for the amendments to Claims 1 and 8, Applicants point to paragraphs [0019] and [0023] of the as-filed specification. However, paragraph [0019] states that “a viral antigen (the envelope glycoprotein) itself is the member of a specific binding pair being recognized by an antibody.” There is nothing in this paragraph to exclude the use of a native viral antigen as the first member of the specific binding pair. Paragraph [0023] refers to several examples of specific binding pairs, such as antibody and the corresponding antigen, and states that “[i]n many instances, members of these binding pairs will not be normally present in the envelope or the capsid of a virus and will thus also not be normally present on the gene delivery vehicles according to the invention.” Again, there is nothing in this paragraph indicating that the claimed invention is intended to exclude native viral antigens as the first member of the specific binding pair. Quite the contrary, the paragraph emphasizes what would need to be done for embodiments where a native viral antigen is not being used as the first member of the specific binding pair, clearly indicating that the scope of the claim is intended to cover embodiments where a native viral antigen is the first member of the specific binding pair. There is certainly nothing in the paragraph to exclude native viral antigens from the scope of the claims.

Thus, the claim amendments introduce new matter.

Conclusion

No claims are allowed.

Art Unit: 1632

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Falk whose telephone number is (571) 272-0728. The examiner can normally be reached Monday through Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (571) 272-0804. The central official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Dianiece Jacobs, whose telephone number is (571) 272-0532.

Anne-Marie Falk, Ph.D.


ANNE-MARIE FALK, PH.D
PRIMARY EXAMINER